

REMARKS

Claim 2 is pending in this application. By this Amendment, claim 2 is amended and non-elected claims 1, 3 and 4 are canceled. No new matter is added by this Amendment. Support for the language added to claim 2 is found at, for example, page 12, line 18 through page 13, line 11 of the specification; Fig. 2A; and original claim 1.

I. Claim Objection

Claim 2 is objected to because it depends from a non-elected claim. Claim 2 is amended to be independent. Thus, this objection is overcome.

II. Rejection Under 35 U.S.C. §102(e)

Claim 2 is rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,962,865 (Hanaoka). This rejection is respectfully traversed.

Claim 2 recites forming an electrode layer having a plurality of conductive layers with an insulating layer interposed between at least two adjacent conductive layers of the plurality of conductive layers, each of the at least two adjacent conductive layers being lower than an uppermost conductive layer. Hanaoka fails to disclose these features.

The Office Action cites item 2a of Hanaoka as disclosing conductive layers lower than an uppermost conductive layer. However, item 2a of Hanaoka is merely an under layer part of an electrode 2 (the electrode 2 consists of the under layer part 2a and an upper layer part 2b). See col. 11, lines 1-10. As seen from the Figures of Hanaoka, there are no insulating layers interposed between the under layer part 2a and the upper layer part 2b, or within the under layer part 2a or the upper layer part 2b.

Accordingly, Hanaoka fails to disclose a plurality of conductive layers with an insulating layer interposed between at least two adjacent conductive layers of the plurality of conductive layers, as recited in claim 2.

For at least the foregoing reason, Hanaoka fails to disclose all of the features of claim 2.

In addition, at page 4, the Office Action acknowledges that Hanaoka fails to explicitly disclose filling the electrode through-hole. However, the Office Action cites col. 12, lines 48-64 of Hanaoka as disclosing that the through-hole can be made to any size necessary, and the side walls can be linearly "a-lined" [sic - aligned] with the section through the center axis. The Office Action takes the position that this disclosure of Hanaoka will allow for the through hole to be filled.

The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish that a reference is anticipatory. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, the disclosure is sufficient. *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268-69 (Fed. Cir. 1991). See also *Kennecott Corp. v. Kyocera Int'l Inc.*, 835 F.2d 1419, 1422, 1423 (Fed. Cir. 1987) (under the doctrine of inherency, the disclosure of a device that inherently performs a function, operates according to a theory, or has an advantage is necessarily a disclosure of that function, theory or advantage, provided the asserted inherent feature is the necessary and only reasonable construction to be given the disclosure by one skilled in the art).

The Office Action acknowledges that Hanaoka fails to disclose filling the electrode through-hole, but asserts that the structure of Hanaoka will allow for the through hole to be filled. However, as discussed above, even if the structure of Hanaoka will allow for the through hole to be filled, the natural result flowing from the teaching of Hanaoka does not necessarily result in the through hole being filled. That is, Hanaoka fails to explicitly or inherently disclose filling the electrode layer through-hole and the substrate through-hole, as recited in claim 2. Accordingly, Hanaoka cannot anticipate the subject matter of claim 2.

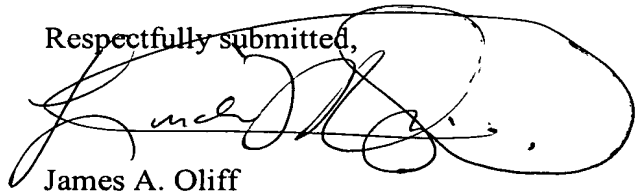
For at least the foregoing reasons, Hanaoka fails to anticipate the subject matter of claim 2. Withdrawal of the rejection is respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claim 2 is earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James A. Oliff", is written over a horizontal line.

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